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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,949

04/05/2004

Michael Rooke

060091.00284

2406

32294

7590

07/15/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

LY, NGHI H

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

07/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,949	<b>Applicant(s)</b> ROOKE ET AL.	
	<b>Examiner</b> Nghi H. Ly	<b>Art Unit</b> 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/09/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-21,23-34,36,45-47,49-66 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-21,23-34,36,45-47,49-66 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 054/08/08 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4        Claims 1, 2, 5, 8, 9, 11-20, 23, 26, 27, 29-34, 36, 45, 46, 49, 52, 53, 55-60, 65, 66 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer et al (2006/0030304A1) in view of Yamaguchi (US 6,871,065).

         Regarding claims 1, 19, 45, 60, 65, 66 and 70, Sofer teaches an system (see fig.1), the arrangement comprising: a first system entity configured to provide a multimedia messaging service to user equipment connected to a network of a system (see Abstract and fig.1, item 20 or 30), and a second system entity configured to provide a value added service (see Abstract and fig.1, item 20 or 30, and see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]) to a user of the user equipment via the multimedia messaging service (see Abstract, [0004], 0020], [0021], [0067], [0068] and [0070]), wherein the first system entity is configured to send a message to the second system entity (see [0020], [0021], [0067], [0068] and [0070]), the message comprises roaming information about the user equipment (see [0019], [0067] and [0068]).

         Sofer does not specifically disclose the second system entity is configured to use the roaming information when providing the value added service to the user equipment.

         Yamaguchi teaches the second system entity is configured to use the roaming information when providing the value added service to the user equipment (see column 8, lines 60-65, also see Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Yamaguchi into the system of Sofer in order to provide the mobile communication system suitable to provide contents to the mobile communication terminal which moves in a wide area, and a mobile communication method and a mobile communication program used in the mobile communication system (see Yamaguchi, column 1, lines 10-15).

Regarding claims 2, 20, 46 and 56, Sofer further teaches the roaming information comprises a roaming status configured to indicate whether the user equipment is roaming outside a home network of the user equipment (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 5, 23 and 49, Sofer further teaches the second system entity is configured to adapt, based on the roaming information (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 8, 26 and 52, Sofer further teaches the second system entity is configured to determine, based on the roaming information, whether the value added service is providable to the user equipment (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 9 and 53, Sofer further teaches the second system entity is configured to select a route or a destination of at least one multimedia message to be delivered to the user of the user equipment according to the roaming information (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 11, 29 and 55, Sofer further teaches the second system entity is configured to determine charging related information according to the roaming information and to add the charging related information to at least one multimedia message to be delivered to the user equipment (see [0020]).

Regarding claims 12 and 30, Sofer further teaches the first system entity is configured to send the message comprising the roaming information about the user equipment to the second system entity in response to a request received from the second system entity (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 13 and 31, Sofer further teaches the first system entity is configured to obtain information about a location of the user equipment from another system entity and to determine the roaming information on the user equipment according to the obtained location information before sending the message comprising the roaming information about the user equipment to the second system entity (see [0018], [0019], [0021], [0065] and see [0004], [0014], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 14, 15, 32, 33, 57 and 58, Sofer further teaches the message comprising the roaming information about the user equipment is an multimedia message interface message (see [0020], [0021], [0067], [0068] and [0070]).

Regarding claims 16 and 34, Sofer further teaches the first system entity comprises a multimedia messaging service center (see [0020], [0021], [0067], [0068] and [0070]).

Regarding claims 17 and 59, Sofer further teaches the second system entity comprises a multimedia messaging service value added service application (see Abstract, [0004], 0014], [0037], [0041], [0042] and [0069]).

Regarding claims 18 and 36, Sofer further teaches the user equipment comprises a mobile station (see fig.2, item 39).

Regarding claims 27, Sofer further teaches selecting (see fig.1, fig.2 and fig.3), a route or a destination of at least one multimedia message to be delivered to a user of the user equipment according to the roaming information (see [0019], [0067] and [0068]).

5. Claims 6, 7, 24, 25, 50, 51 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer et al (2006/0030304A1) in view of Yamaguchi (US 6,871,065) and further in view of Fenton et al (US 2003/0193967A1).

Regarding claims 6, 24, 50, 61 and 63, the combination of Sofer and Yamaguchi teaches claims 1, 19, 45, 60, 65, 66 and 70. The combination of Sofer and Yamaguchi does not specifically disclose the second system entity is configured to encrypt or decrypt at least part of the content of the at least one multimedia message to be delivered to the user equipment according to the roaming information.

Fenton teaches the second system entity is configured to encrypt or decrypt at least part of the content of the at least one multimedia message to be delivered to the user equipment according to the roaming information (see [0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Fenton into the system of Sofer and Yamaguchi in order to process the multimedia message using a customized process (see Fenton, Abstract).

Regarding claims 7, 25, 51, 62 and 64, the combination of Sofer and Yamaguchi teaches claims 1, 19, 45, 60, 65, 66 and 70. The combination of Sofer and Yamaguchi does not specifically disclose the second system entity is configured to use digital rights management to perform the encryption or decryption by using digital rights management.

Fenton teaches the second system entity is configured to use digital rights management to perform the encryption or decryption by using digital rights management (see [0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Fenton into the system of Sofer and Yamaguchi in order to process the multimedia message using a customized process (see Fenton, Abstract).

6. Claims 3, 10, 21, 28, 47 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer et al (2006/0030304A1) in view of Yamaguchi (US 6,871,065) and further in view of Elizondo (US 6,917,813).

Regarding claims 3, 21 and 47, the combination of Sofer and Yamaguchi teaches claims 1, 19, 45, 60, 65, 66 and 70. The combination of Sofer and Yamaguchi does not specifically disclose the roaming information comprises an address of a



switching centre which the user equipment is using.

Elizondo teaches the roaming information comprises an address of a switching centre which the user equipment is using (see column 2, lines 18-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Elizondo into the system of Sofer and Yamaguchi in order to provide SMS service when different SS7 signaling networks are in use (see [0012]).

Regarding claims 10, 28 and 54, Sofer further teaches the second system entity is configured to determine a location of the user equipment according to the address of the switching center that the user equipment is using and provide the user equipment with information relating to the determined location (see [0018], [0019], [0021], [0065]).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-3, 5-21, 23-34, 36, 45-47, 49-66 and 70 have been considered but are moot in view of the new ground(s) of rejection.

On page 17 of applicant's remarks, applicant argues that "The Office Action is listed as final, but this designation is incorrect. The Office Action stated that Applicant's amendment necessitated the new grounds of rejection, but the response filed December 7, 2007, did not contain any amendments. Accordingly, the Office Action has been improperly designated a "final" Office Action, and consequently withdrawal of the finality of the Office Action is respectfully requested".

In response, applicant did amend claims (see claims filed on 06/25/07). Therefore, the final-rejection of the last Office action (01/16/08) was issued to replace the previous final-rejection (09/07/07).

On page 18 of applicant's remarks, applicant argues that "Sofer is not prior art, since it was filed on April 5, 2005, which is later than the filing date of the present application. Thus, Sofer itself does not qualify as prior art under 35 U.S.C. 102(e). It should be noted that Sofer appears to be related to U.S. Patent No. 6,920,487, which was filed earlier than Sofer. Accordingly, in order to expedite".

In response, Sofer is prior art, it was filed on April 5, 2005, which is later than the filing date of the present application. However, Sofer itself does qualify as prior art since Sofer is a continuation (Not "related" as alleged by the applicant) of U.S. Patent No. 6,920,487, which was filed earlier than the filing date of applicant.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571)272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 2617

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

/Nghi H. Ly/  
Primary Examiner, Art Unit 2617